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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,576

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Thomas Buchberger

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EXAMINER

CHAUDRY, ATIF H

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,576	Applicant(s) BUCHBERGER ET AL.	
	Examiner ATIF H. CHAUDRY	Art Unit 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22,23,25-27 and 29-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) 22,23,25-27 and 29-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/30/2009 has been entered.

Status of the claims

Applicant's amendment as filed on 03/30/2009 has been entered. The amendment added claim 43 and amended claim 25-27, 29-31, 33, 35, 36, 39, 40. Currently claims 22, 23, 25-27, 29-43 are pending in this application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Cadman et al (US Pat 2498482).

4. Cadman et al (Fig. 2) discloses a valve comprising a valve holder 33, a valve insert 30 screwed to the valve holder 33, a valve piston 48 supported slidably in the valve insert 30, a compression spring 50, acting upon the valve piston 48 with a

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pressure force acting in the closing direction, and an adjusting shim 47 disposed between the valve piston 48 and the compression spring 50 such that the compression spring 50 is braced on one end on a bottom piece of the valve holder 33 and on the other on a face of the adjusting shim 47 facing away from the valve piston 48 wherein the valve holder 33 is cup-shaped and has at least two subregions, the first subregion 35 with smaller diameter receiving the valve spring 50, and the subregions merge with one another in steplike fashion, and wherein the steplike transition of the valve holder 33 formed by the different diameter regions is seated on the valve insert 30 such that the valve insert 30 is received in second subregion.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 22 is alternatively rejected and claims 23 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482) further in view of Ichikawa et al. (US Patent 5002090).

Regarding claims 22 and 31 Jay et al (fig. 2, 3) discloses a pressure limiting valve comprising a valve holder 14, 15, a valve insert 10 connected to valve holder, a piston 11, a compression spring 28 acting upon the piston 11 through an adjusting shim 25.

Jay et al fails to disclose a valve holder comprising cup shaped holder having two subregions. Cadman et al (Fig. 2) teaches a valve comprising a valve holder 33, a valve insert 30 screwed to the valve holder 33, a valve piston 48 supported slidably in the valve insert 30, a compression spring 50, acting upon the valve piston 48 with a pressure force acting in the closing direction, and an adjusting shim 47 disposed between the valve piston 48 and the compression spring 50 such that the compression spring 50 is braced on one end on a bottom piece of the valve holder 33 and on the other on a face of the adjusting shim 47 facing away from the valve piston 48 wherein the valve holder 33 is cup-shaped and has at least two subregions, the first subregion 35 with smaller diameter receiving the valve spring 50, and the subregions merge with one another in steplike fashion, and wherein the steplike transition of the valve holder 33 formed by the different diameter regions is seated on the valve insert 30 such that the valve insert 30 is received in second subregion. Cadman et al teaches an outflow opening 34 in the holder 33. It would have been obvious to a person having

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ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a valve holder and a valve insert as taught by Cadman et al as an alternative valve housing assembly.

Jay et al (fig. 5) discloses flat places extending parallel to the axis of the piston

35. Jay et al. fails to disclose the flat places at the outer circumference of the valve piston. Ichikawa et al. (Fig. 1) teaches piston valve having flow paths between a valve piston 4 and a corresponding housing surface comprising flat surfaces 4b on the outer circumference of the valve piston 4. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with flat surfaces on the outer circumference of the valve piston as taught by Ichikawa et al. as an alternative fluid flow path between piston and valve housing.

Jay et al discloses two flat places uniformly distributed over the circumference of the piston (parallel in Fig. 5, oriented at angle in Fig. 3) but fail to disclose three flat places. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided three flat surfaces on the piston disclosed by Jay et al, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

4. Regarding claim 23, Jay et al discloses the insert 10 having a cup shaped recess to hold the adjusting shim 25.

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5. Claims 25, 27, 29, 30, 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482) further in view of Weirich (US Patent 4313463) and Ichikawa et al. (US Patent 5002090).

Regarding claims 25, 27, 29, 35-37, Jay et al (fig. 2, 3) discloses a pressure limiting valve comprising a valve holder 14, 15, a valve insert 10 connected to valve holder, a piston 11, a compression spring 28 acting upon the piston 11 through an adjusting shim 25.

Jay et al fails to disclose a valve holder comprising cup shaped holder having two subregions. Cadman et al (Fig. 2) teaches a valve comprising a valve holder 33, a valve insert 30 screwed to the valve holder 33, a valve piston 48 supported slidably in the valve insert 30, a compression spring 50, acting upon the valve piston 48 with a pressure force acting in the closing direction, and an adjusting shim 47 disposed between the valve piston 48 and the compression spring 50 such that the compression spring 50 is braced on one end on a bottom piece of the valve holder 33 and on the other on a face of the adjusting shim 47 facing away from the valve piston 48 wherein the valve holder 33 is cup-shaped and has at least two subregions, the first subregion 35 with smaller diameter receiving the valve spring 50, and the subregions merge with one another in steplike fashion, and wherein the steplike transition of the valve holder 33 formed by the different diameter regions is seated on the valve insert 30 such that the valve insert 30 is received in second subregion. Cadman et al teaches an outflow

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opening 34 in the holder 33. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a valve holder and a valve insert as taught by Cadman et al as an alternative valve housing assembly.

Jay et al fails to disclose an outflow conduit at an angle to the longitudinal axis. Weirich (fig. 1) teaches a pressure relief valve 10 comprising a cup shaped valve holder 11 with an outer jacket face having an outflow conduit 11' at an angle relative to the longitudinal axis of the valve holder 11 connecting the outer jacket face to inside of valve. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a valve holder having outflow conduit as taught by Weirich as an alternative fluid outlet path.

Jay et al. fails to disclose the flat places at the outer circumference of the valve piston. Ichikawa et al. (Fig. 1) teaches piston valve having flow paths between a valve piston 4 and a corresponding housing surface comprising flat surfaces 4b on the outer circumference of the valve piston 4. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with flat surfaces on the outer circumference of the valve piston as taught by Ichikawa et al. as an alternative fluid flow path between piston and valve housing.

Jay et al discloses two flat places uniformly distributed over the circumference of the piston (parallel in Fig. 5, oriented at angle in Fig. 3) but fail to disclose three

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flat places. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided three flat surfaces on the piston disclosed by Jay et al, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Regarding claim 29, Jay et al discloses (Fig. 6) the piston 26 comprising an end surface 36 and an outer circumferential surface having flat places 35.

7. Regarding claim 33 and 34, Jay et al discloses the adjusting shim 25 having a fluid recess 29 disposed eccentrically.

8. Regarding claim 38, Jay et al discloses an outlet 22 provided in the valve insert.

9. Regarding claims 30 and 32, Jay et al discloses two flat places uniformly distributed over the circumference of the piston (parallel in Fig. 5, oriented at angle in Fig. 3) but fail to disclose three flat places. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided three flat surfaces on the piston disclosed by Jay et al, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

10. Claims 39, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482), Weirich (US Patent 4313463) and Ichikawa et al. (US Patent 5002090) further in view of Yie (US Patent 5241986).

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11. Jay et al fails to disclose a piston rod. Yie teaches a pressure relief valve 10 comprising a piston 15 having a piston rod 17 protruding into the cup shaped recess of valve holder 11 and surrounded by a spring 22 such that the adjusting shim 18 is slipped onto the piston rod 17 and rests on a steplike seat. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a piston rod as taught by Yie in order to help align the piston and the spring.

12. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482), Weirich (US Patent 4313463) and Ichikawa et al. (US Patent 5002090) further in view of LINDEBOOM (US Patent 3346009).

13. Jay et al fails to disclose a conical spring. LINDEBOOM (fig. 1) teaches a pressure actuated valve comprising a piston operated by a conical spring. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a conical spring as taught by LINDEBOOM as an alternative biasing mechanism.

14. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482), Weirich (US Patent 4313463) and Ichikawa et al. (US Patent 5002090) further in view of Lauer et al (US Patent 6523913).

15. Jay et al fails to disclose valve parts joined together by caulking. Lauer et al (fig. 1, col 2, line 48), teaches a pressure control valve comprising a valve holder 14 and a

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valve insert joined together by caulking. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with caulking as a joining method as taught by Lauer et al as an alternative method of valve assembly.

16. Claim 36 is alternatively rejected and claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482) further in view of Platt et al (US Patent 4413646) and Ichikawa et al. (US Patent 5002090).

Jay et al (fig. 2, 3) discloses a pressure limiting valve comprising a valve holder 14, 15, a valve insert 10 connected to valve holder, a piston 11, a compression spring 28 acting upon the piston 11 through an adjusting shim 25.

Jay et al fails to disclose a valve holder comprising cup shaped holder having two subregions. Cadman et al (Fig. 2) teaches a valve comprising a valve holder 33, a valve insert 30 screwed to the valve holder 33, a valve piston 48 supported slidably in the valve insert 30, a compression spring 50, acting upon the valve piston 48 with a pressure force acting in the closing direction, and an adjusting shim 47 disposed between the valve piston 48 and the compression spring 50 such that the compression spring 50 is braced on one end on a bottom piece of the valve holder 33 and on the other on a face of the adjusting shim 47 facing away from the valve piston 48 wherein the valve holder 33 is cup-shaped and has at least two subregions, the first subregion 35 with smaller diameter receiving the valve spring 50, and the subregions merge with one another in

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steplike fashion, and wherein the steplike transition of the valve holder 33 formed by the different diameter regions is seated on the valve insert 30 such that the valve insert 30 is received in second subregion. Cadman et al teaches an outflow opening 34 in the holder 33. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a valve holder and a valve insert as taught by Cadman et al as an alternative valve housing assembly.

Jay et al fails to disclose an outflow conduit at an oblique angle to the longitudinal axis. Platt et al teaches a valve comprising a valve holder housing having an oblique outlet in the valve holder housing to reduce erosion of the valve surface. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with an oblique outlet as taught by Platt et al in order to reduce erosion of the valve surface.

Jay et al. fails to disclose the flat places at the outer circumference of the valve piston. Ichikawa et al. (Fig. 1) teaches piston valve having flow paths between a valve piston 4 and a corresponding housing surface comprising flat surfaces 4b on the outer circumference of the valve piston 4. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with flat surfaces on the outer circumference of the valve piston as taught by Ichikawa et al as an alternative fluid flow path between piston and valve housing.

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Jay et al discloses two flat places uniformly distributed over the circumference of the piston (parallel in Fig. 5, oriented at angle in Fig. 3) but fail to disclose three flat places. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided three flat surfaces on the piston disclosed by Jay et al, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

17. Applicant's arguments filed 03/30/09 have been fully considered but they are not persuasive. Regarding claim 31, Ichikawa et al. has been cited to show incorporation of flat surfaces on the outer circumferential surface of the piston. Regarding claim 36, Applicant's argument that addition of a lateral outflow conduit as taught by Weirich would destroy the references of Jay et al or Cadman is not persuasive since Weirich is being cited to show incorporation of an alternative location of the outflow conduit and not an additional outflow conduit.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ATIF H. CHAUDRY whose telephone number is (571)270-3768. The examiner can normally be reached on Mon-Fri Alternate Friday off 9-5 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571)272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Atif H Chaudry/
Examiner, Art Unit 3753

/John Rivell/
Primary Examiner, Art Unit 3753

4/24/2009